Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICKY S. PALMER and LARRY G. PALMER

Appeal No. 1998-3126
Application No. 08/479,569

ON BRIEF

Before THOMAS, JERRY SMITH, and LEVY, Administrative Patent Judges.

LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 16-23, 25-29, 31-37, 39-43, and 51-59, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to video and audio multimedia

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Reed et al. (Reed)	5,241,671	Aug. 31, 1993 (filed Oct. 26, 1989)
Sato et al. (Sato)	3,396,338	Mar. 07, 1995 (filed Feb. 21, 1991)
Bluthgen	5,587,979	Dec. 24, 1996 (effectively filed Jan. 17, 1989)

Ludwig, "Integration of CAD/CAE with Multimedia Teleconferencing and Messaging Via Broadband Networks and Shared Resource Servers" IEEE Systems Integration '90 Conference Proceedings, May 1990, pp. 136-143.

Microsoft® Windows™ (Microsoft), User's Guide for the Microsoft Windows Operating System, 1991, pp. 42-46.

Claims 54-59 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ludwig in view of Microsoft and Reed.

Claims 16-23, 25, 26, 29, 31-37, 39, 42, 43, and 51-53 stand rejected under 35 U.S.C. § 103 as unpatentable over Ludwig in view of Microsoft, Reed, and Bluthgen.

Claims 27, 28, 40, and 41 stand rejected under 35 U.S.C. § 103 as unpatentable over Ludwig in view of Microsoft, Reed, Bluthgen, and further in view of Sato.

Rather than reiterate the conflicting viewpoints advanced by

support of the rejections, and to appellants' brief (Paper No. 32, filed December 2, 1997) and reply brief (Paper No. 35, filed March 26, 1998) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we affirm-in-part.

1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or

1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Appellants (brief, page 6) have grouped the claims as follows: claims 16-22 and 25-28; claim 23; claims 29, 31-37, 39-41, and 51-53; claim 42; claim 43; claims 54, 55, and 57-59; and claim 56. We will address the groups in the order that they have been argued by appellants and the examiner. To the extent that appellants have argued more than one claim within a group, we will separately address the claims additionally argued.

We consider first the rejection of claims 54-59 under 35 U.S.C. § 103 based on the teachings of Ludwig considered with Microsoft and Reed. We begin with claims 54, 55, and 57-59.

Appellants present specific arguments with respect to independent claim 54. Accordingly, we consider claim 54 to be representative of the group. The examiner's position (answer, page 4) is that Ludwig shows user selectable functions and an audio retrieval program generating an audio description of topics, but that Ludwig "does not show a help key and

deficiencies in Ludwig, the examiner turns to Microsoft for a teaching of a help key and simultaneous selection for the purpose of helping a user with system documentation. The examiner acknowledges (id.) that the function is selected after initial selection of the help key, but takes the position that "the help key remains selected after being pressed as evidenced by the presence of the help screen and thus, both help key and function are simultaneously selected when the function is selected." The examiner asserts (answer, page 11) that:

> It is noted that the claims call for simultaneity of selection rather then [sic, than] initiation of selection. This must be so because to require absolute simultaneity of triggering in the nanosecond world of computers would be a statistically impossible criterion.

The examiner adds (answer, page 4) that "even a more narrow interpretation of 'simultaneous' would be an obvious embodiment because toggled sequential selections as in Microsoft and physically simultaneous selections were art recognized equivalents." The examiner (answer, page 4) additionally relies upon Reed for a teaching of user selectable functions associated

dedicated help key with an application function as a way of triggering help." Appellants further assert (brief, page 7) that "[n]one of the cited references discloses the claimed functionality, *i.e.*, a similar method for providing an explanation of an application program's selectable functions without the need to invoke a separate menu-driven help system." Appellants additionally assert (id.) that in contrast to Windows, appellants' invention allows audio information to be acquired prior to activation of the user selectable function.

Appellants further assert (brief, page 9) that:

> According to the invention, while the application is operating, the help may be activated by the simple simultaneous selection method. Multi-levels of help menus need not be navigated, specific topics need not be found, nor needless dialog boxes activated as in the Microsoft® manual. Instead, a concise audio description is reproduced, which need not interrupt the operation of the video teleconferencing application.

We find that Microsoft discloses simultaneous selection of a selectable function and a help key. Microsoft discloses five methods of obtaining help. A user can press help key F1 and then select a function such as "How to Use Help" (page 44). In

user then presses key F1 see a description of the menu item. For example, to request help information regarding the "View" menu item, a user would select "View" on the menu bar using the keyboard, and then press key F1 to see a description of the item "View."

We agree with the examiner (answer, page 4) that the help key remains selected after being pressed as evidenced by the presence of the help screen, and that when the function is then selected, both the help key F1 and the function are simultaneously selected. We likewise find that when the keyboard is used to select an item on a menu, the item remains selected, and pressing F1 to see a description of the item provides a simultaneous selection of both items, because if an item were selected and then unselected, pressing F1 would not produce a description of the item.

We additionally agree with the examiner (answer, page 11) that "the claims call for simultaneity of selection rather than [simultaneous] initiation of selection." Claim 54 as drafted, does not require that the help key is pressed at the same time as

which is not precisely the same. We find that, as drafted, claim 54 is broad enough to read on selecting a function at a time when the help screen has been selected by the help key F1, or selecting an item (function) from the menu and then pressing F1 to see the description of the item.

In addition, the examiner asserts that under a more narrow interpretation of the term "simultaneous," that the differences between Microsoft and the claim language would have been obvious, and provides reasons, in support thereof (answer, pages 4 and 11). The examiner's position (brief, page 11) is that "toggled sequential selections as in Microsoft and physically simultaneous selections were art recognized equivalents at the time of the invention in the arts of operator interfaces." Appellants have not addressed this obviousness argument. In addition, we observe that appellants' specification (page 40) recites that by simultaneously selecting a pushbutton while holding down a keyboard help key, a description of the selected function is provided. Thus, we find that the help key and selected function do not need to be simultaneously initiated, but rather that the

We are not persuaded by appellants' assertion (brief, page 7) that none of the references discloses the same functionality of "providing an explanation of an application programs selectable functions without the need to invoke a separate menu-driven help system." We find that claim 54, as drafted, does not require explanation of a function without the need to invoke a separate menu-driven system. The claim recites "an application program executing on the computer providing a plurality of user selectable functions," and recites how a selectable function is retrieved. Thus, we find no limitation reciting that an explanation of a function is provided without invoking a separate menu-driven system.

We note that in appellants' invention (figure 18 and specification, pages 39-44) menu bar 512 contains selectable buttons 514, 516, 518, 520, and 522. The help pushbutton 522 is used to access on-line documentation by activating a second level information pop-up window 750. However, by selecting a pushbutton, such as 514 or 516, while holding down the keyboard help key, a description of the function of the pushbutton is

topics is obtained by selecting an item on the menu bar, such as "View" or "Test," and obtaining a description of the selected item by pressing F1.

Appellants further assert (reply brief, page 2) that none of the reference describes topic-oriented audio help, and that there is no motivation from the references to generate audible, rather than the text-based help common at the time of the invention.

The examiner's position (answer, page 4) is that Ludwig discloses an audio retrieval program generating an audio description of topics.

We find that Ludwig discloses a multimedia teleconferencing and messaging system in an environment that includes text, graphics, audio, and video (page 136). The multimedia database server includes an image-description oriented verbal natural language front-end for queries (page 139). Database objects include pointers to audio/video players, laserdisk players and VCRs (page 140). We note that Ludwig does not disclose the use of a help system for assistance in using the multimedia system. Reed discloses a database search system that retrieves

functions for assisting the user in finding information while using the database system, such as the Idea Search entry path which "assists the user in finding information regarding any topic for exploration," and discloses that a step-by-step tutorial is provided, entitled "Getting Started." In addition, Reed further discloses (col. 6, lines 64-65) that a help function is provided, but is not illustrated. A large part of the encyclopedia database consists of articles which contain text, photographs, etc., as well as audio and animation data (col.11, lines 56-59). Some of the terms in the articles are underlined (col.11, lines 66-68). By clicking on an underlined word with a mouse, a window appears showing the definition of the word. An audio pronunciation of the word also occurs. An audio icon is also displayed in the glossary window prompt line. Accompanying the text are numerous functions represented by icons. These include a Moving Picture display function, and an Audio function (col. 12, lines 5-16). As shown in figure 7, if an associated audio icon exists adjacent to text at step 300, the user can click on the icon causing the audio selection to be played at

generates an audio description of topics, i.e., the features that the examiner relies upon in Ludwig. Thus, we find Ludwig to be cumulative to Reed. Because Reed does not illustrate the disclosed help system, we find that one of ordinary skill in the art would have been motivated to use the specific help system taught by Microsoft, in Reed, who teaches that a multimedia computer system should have a help system.

As to the issue of using audio help instead of textual help, we find that Reed's multimedia computer system retrieves audio and video information, in addition to textual information. Because Reed specifically teaches audio pronunciation of text; that text be accompanied by separate icons providing audio, and separate icons providing moving pictures, we find that upon providing Reed with the help system of Microsoft, that the help would be in the form of text, icons for audio, and icons for motion pictures, because this is how Reed provides information to the user of the system. Claim 54, as drafted, uses the transitional phrase "comprising" and does not preclude the use of both text, audio, and moving pictures. Thus, we find that claim

U.S.C. § 103 is affirmed.

Turning next to claim 56, appellants assert (brief, page 9) that:

> None of the references suggests that a system of data files, associated with the various user selectable functions, should be used as a mechanism for storing the digital encoded audible descriptions of those functions.

The examiner's position (answer, page 12) is that "[i]t is inherent in the Microsoft system that individual help modules are stored in individual help files characterized by the '.HLP' extension, e.g. EXCEL.HLP provides help for excel functions. This was notoriously well known at the time of the invention."

Appellants respond (reply brief, page 3) by asserting that "[t]he relevance of this file structure has never been previously-raised in the prosecution of this application and, more importantly, evidence of the file structure at the time of the present invention has not been made part of the record."

We consider the examiner's assertion that "[t]his was notoriously well known at the time of the invention" as the taking of official notice by the examiner, and find this taking

finding of fact relying on official notice may be easily traversed by either denying the fact or avering that appellant is without knowledge of its truth or falsity, which has the effect of a denial. If a party is without knowledge or information sufficient to form a belief as to the truth of an averment, the party shall so state and this has the effect of a denial. A proper traverse indicates that a fact is genuinely contested and a reference must be found. Mere argument that the official notice is not supported by a reference is not a traverse because such assertion does not indicate whether the fact is actually denied. Appellants could have challenged the accuracy of the examiner's statement but have not done so. Appellants' assertion that this point has not been previously raised does not address the accuracy of the examiner's statement. Nor does appellants' statement that there is no evidence in the record to support the examiner's assertion, specifically challenge the examiner's assertion. Appellants' arguments merely beg the point. Because appellants have not challenged the accuracy of the examiner's

the rejection of claim 56 under 35 U.S.C. § 103 is affirmed.

We turn next to the rejection of claims 16-23, 25, 26, 29, 31-37, 39, 42, 43, and 51-53. The examiner adds Bluthgen to the basic combination of Ludwig, Microsoft, and Reed. We begin with claims 29, 31-37, 39, and 51-53[1]. Appellants only present specific arguments with respect to claim 29. Accordingly, we consider claim 29 to be representative of the group. We make reference to our findings, supra, with respect to the teachings of Ludwig, Reed, and Microsoft with respect to claim 54. The examiner additionally relies upon Bluthgen for a teaching of audio and video files stored as separate serial packets accessible by computer workstations.

Appellants assert (brief, pages 10 and 11) that Ludwig is directed to a hybrid analog/digital teleconferencing system, and does not mention a particular user interface scheme. Appellants further assert (brief, page 11) that the system in Microsoft

> is not triggered from a video teleconference application window, does not supply information concerning video teleconferencing, does not separate

We note that the examiner does not rely upon Microsoft alone for a teaching of triggering help from a video teleconferencing application window. Ludwig is relied upon for a teaching of video teleconferencing. Nor does the examiner rely upon Microsoft for the feature of providing audio/video multimedia help as required by claim 29. As discussed, supra, with respect to claim 54, Reed suggests this feature. In addition, we are not persuaded by appellants' assertion that Microsoft does not separate data files associated with selectable topics for the reasons discussed, supra, with respect to claim 56.

However, we find that none of the references are directed to a multimedia documentation system for a video teleconferencing workstation. Nor do we find any teaching or suggestion for the claimed video teleconferencing documentation function. We agree with appellants (brief, page 11) that Ludwig does not mention a particular user interface scheme. Accordingly, we agree with appellants (reply brief, pages 2 and 3) that the references fail to suggest triggering audio and video documentation help from a video teleconference application window. We find that the

Ludwig, Reed, Microsoft, and Bluthgen to arrive at the claimed invention. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)(citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

Because none of the references addresses a multimedia documentation system for a video teleconferencing workstation; the claimed video teleconferencing documentation function, nor triggering audio and video documentation help from a video teleconference application window, we are not persuaded that teachings from the applied prior art would appear to have suggested the claimed limitations. We therefore find that the

Bluthgen. Accordingly, the rejection of claims 29, 31-37, 39, 42, 43, and 51-53 under 35 U.S.C. § 103 is reversed.

We turn next to claims 16-22 and 25, and 26[2]. Appellants present specific arguments with respect to independent claim 16. Accordingly, we consider independent claim 16 to be representative of the group. The examiner's position (answer, pages 5-7) is that Ludwig does not teach the claimed specific system documentation. The examiner further asserts that Ludwig does not teach user selectable functions associated with topic fields. The examiner additionally asserts that Ludwig does not teach audio and video data files stored as separate serial packets accessible by computer workstations. To overcome these deficiencies in Ludwig, the examiner turns to Microsoft for a teaching of system documentation. The examiner additionally turns to Reed for a teaching of user selectable functions associated with topic fields. The examiner additionally turns to Bluthgen for a teaching of audio and video data files stored in separate serial packets accessible by the workstation. Appellants assert (brief, page 11) that independent claim 16 adds

selectable functions generate the audio and visual multimedia help. The second selectable functions provide textual help. We find that claim 16 requires that the documentation menu displayed on the workstation includes three items:

> a) a topic field for indicating a topic for which documentation is available;
>
> b) a first user selectable function associated with the topic field; and
>
> c) a second user selectable function associated with the topic field;

In Microsoft, the documentation menu includes a topic field which will include a topic. Clicking on a topic in a topic field brings up information on the selected topic. However, claim 16 requires first and second user select-able functions as part of the documentation field. As we stated, supra, with respect to claim 54, in Reed when a topic selected, the information provided may have accompanying icons for audio and audio/video. This is not the same as having both of the first and second user selectable functions, along with the topic field, as part of the documentation menu. We find no teaching or suggestion of these

examiner has failed to establish a prima facie case of obviousness of the invention set forth in claim 16. Accordingly, the rejection of claim 16, and claims 17-23, 25, and 26 dependent therefrom, under 35 U.S.C. § 103 is reversed.

We turn next to the rejection of claims 27, 28, 40, and 41 under 35 U.S.C. § 103. The examiner (brief, page 9) adds Sato to the basic combination of Ludwig, Microsoft, Reed, and Bluthgen for a teaching of "video display in response to audio corresponding to video timing information." We reverse this rejection because Sato does not overcome the basic deficiencies of Ludwig, Reed, Microsoft, and Bluthgen. Accordingly, the rejection of claims 27, 28, 40, and 41 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 16-23, 25-29, 31-37, 39-43, and 51-53 under 35 U.S.C. § 103 is reversed. The decision of the examiner to reject claims 54-59 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a).

AFFIRMED-IN-PART

JAMES D. THOMAS Administrative Patent Judge	)	
JERRY SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES

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APPENDIX A
Claims 16 and 54

16. A multimedia documentation apparatus for a multimedia computer workstation, comprising

means for displaying a documentation menu on the workstation display, the documentation menu comprising

a) a topic field for indicating a topic for which documentation is available;

b) a first user selectable function associated with the topic field; and

c) a second user selectable function associated with the topic field;

a data file accessible by the computer workstation that contains both-digitized audio and video documentation stored as separate serial packets, the audio and video documentation being help information describing an operation of the multimedia computer workstation relative to the topic;

retrieval means for retrieval and playback by the workstation of video and audio documentation in the data file in response to activation of the first user selectable function associated with the topic field; and

text retrieval means for retrieval and display by the workstation of textual

APPENDIX A (cont.)

54. A multimedia help system for a multimedia computer, comprising:

an application program executing on the computer providing a plurality of user selectable functions;

a help key on a keyboard of the computer; and an audio retrieval program executing on the computer for generating an audible description of one of the user selectable functions in response to simultaneously selecting that user selectable function and the help key.